

REMARKS

Claims 1-26 and 35-68 are pending in the application, with claims 1-26, 39-48, and 51-60 having been withdrawn from consideration by the Examiner. By this Reply, claims 35, 37, 38, 49, and 50 have been amended, claims 27-34 have been canceled, and new claims 61-68 have been added. No new matter has been added.

Initially, Applicant respectfully requests reconsideration of the election of species requirement set forth in the October 17, 2005 Office Action in light of the Examiner's statements made in the Office Action dated July 24, 2006. Applicant submits that the election of species requirement is improper at least with regard to claims 1-26.

Particularly, the withdrawn species of FIGS. 8A-9B differs from the elected species of FIGS. 11A-12B, *inter alia*, in the positioning of the wings. For example, the species of FIGS. 8A-9B includes wings on a shield, while the species of FIGS. 11A-12B includes wings on a needle hub. These variations are reflected in the various figures of the application. In the outstanding Office Action, the Examiner relies on U.S. Patent No. 5,501,672 to Firth et al. ("Firth") in rejecting claims 35-38, 49, and 50 under 35 U.S.C. § 103(a), even though Firth allegedly discloses wings attached to a shield (similar to FIGS. 8A-9B in the present application). Accordingly, the Examiner's own search and analysis evidences the lack of any undue search or examination burden on the Examiner with respect to the allegedly patentably distinct species of FIGS. 8A-9B and FIGS. 11A-12B.

The Examiner then alleges that U.S. Patent Publication No. 2004/0143226 to Marsden ("Marsden") teaches that "it is known to use the wings either attached to the needle hub ... or to the shield." The Examiner further states that any modification

pursuant to this teaching would involve “only routine skill in the art such as a mere reverse [sic] essential working parts.” Thus, the Examiner is essentially alleging that elected species of FIGS. 11A-12B is not patentably distinguishable from the alleged species of FIGS. 8A-9B, at least based on the positioning of the wings, in view of Firth, Marsden, or a combination thereof.

Such an allegation by the Examiner **directly conflicts** with the statement in the election of species requirement that the species of Figures 8A-9B is patentably distinct from the species of Figures 11A-12B. Indeed, according to the Examiner’s most recent assertions discussed above, Figures 8A-9B are not patentably distinct from Figures 11A-12B. Applicant submits that the Examiner cannot have it both ways. If the Examiner is going to maintain the position that the claims directed to Figures 11A-12B are not patentably distinguishable from the species of Figures 8A-9B, then the Examiner **must** withdraw the election of species requirement between these two alleged species.

Accordingly, Applicant respectfully requests withdrawal of the election of species between the alleged species of Figures 8A-9B and the alleged species of Figures 11A-12B. Furthermore, in response to such withdrawal, Applicant submits that claims 1-34 are directed to a combined species of Figures 8A-9B, 11A-12B and requests rejoinder and examination of claims 1-34 as directed to the combined species.

Claims 37, 38, 49, and 50 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Although Applicant maintains disagreement with this rejection, as discussed in the Reply filed on May 18, 2006, in order to expedite prosecution, Applicant has amended claims 37, 38, 49, and 50 to define the subject

matter more consistent with the disclosure, for example, paragraphs [63] to [67].

Accordingly, Applicant respectfully requests withdrawal of this rejection.

Claims 35-38, 49, and 50 were rejected under 35 U.S.C. § 103(a) over Firth in view of Marsden. Applicant respectfully traverses this rejection.

Regarding independent claim 35, Firth does not disclose or suggest a butterfly needle assembly comprising, *inter alia*, (1) a locking mechanism integral with a needle hub having a tab protruding radially from the needle hub; (2) a cutout extending from the shield at a distal end of the dorsal track; and (3) the tab being configured to travel along the dorsal track to engage the cutout at the distal end of the dorsal track thereby locking the needle within the shield.

To the contrary, Firth discloses a needle 70 and slider member 112 in a body member 110. The slider member 112 includes a boss 114, which fits into the first and second pockets 116a, 116b. Firth does not disclose or suggest any structure resembling “a cutout extending from the shield...,” as evidenced by the lack of identification of such element in the Office Action.

In the Office Action, the Examiner alleges that the boss 114 is a “locking means.” Applicant respectfully disagrees and submits that the boss 114 does not lock the slider member 112 relative to the body member 110. As shown in FIG. 27, the boss 114 includes a sloped surface facing away from the needle 70. As a result, any force on the slider member 112 in the proximal direction (opposite to needle 70), would cause relative movement between the slider member 112 and the body member 110 because the sloped surface of the slider member 112 would not lock against any structure of the body member 110. Thus, even when the position of the boss 114 coincides with the

distal pocket 116a, the slider member 112 is not locked within the body member 110, as recited in claim 35. Indeed, nowhere does Firth mention that the boss 114 operates to lock the slider member 112 within the body member 110. Accordingly, Firth does not disclose or suggest a locking mechanism or a cutout, as recited in claim 35.

Marsden does not overcome the above-noted deficiencies of Firth and is not relied upon for such teachings. Marsden is relied upon only for the alleged teaching of interchanging wings between a needle hub and a shield. Therefore, Applicant submits that Firth and Marsden, alone and in combination, fail to disclose the features of independent claim 35. Accordingly, the § 103(a) rejection of claim 35 should be withdrawn.

Additionally, new independent claim 61 is allowable for reasons similar to those discussed above in connection with independent claim 35. Claims 36-60 depend from independent claim 35 and are therefore allowable for at least the same reasons that claim 35 is allowable, as well as for their own unique features. Similarly, claims 62-68 depend from independent claim 61 and are therefore allowable for at least the same reasons that claim 61 is allowable, as well as for their own unique features. Applicant respectfully requests that withdrawn claims 39-48 and 51-60 be re-joined at this time as being dependent upon an allowable generic claim.

In view of the foregoing amendments and remarks, Applicant respectfully requests prompt examination of this application and timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art, with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

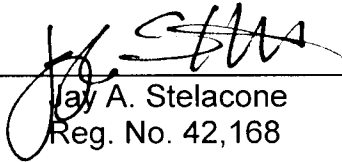
If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicant's undersigned attorney at 443-482-3390.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 50-4082.

Respectfully submitted,

Dated: January 24, 2007

By: _____


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